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## **A GUIDE TO TRADE-MARKS**



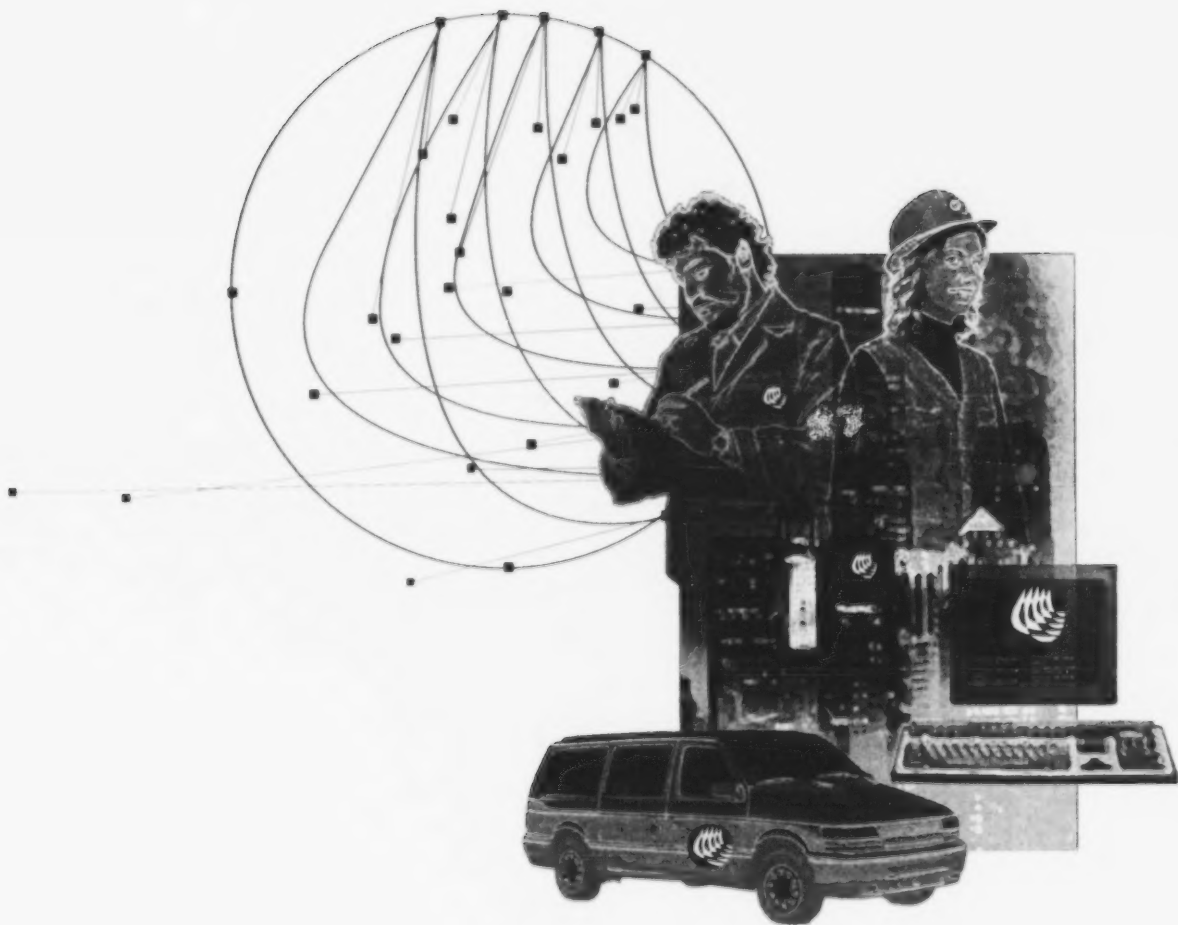
June 2005

**Canada**

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## A GUIDE TO TRADE-MARKS



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## INTRODUCTION

### Your identity in the marketplace

Success in the business world depends largely on the message you convey and the image you project. This was the case 50 years ago and is even more true in the competitive global marketplace of today. You may have an excellent product or service to offer, but if people can't pick you out easily in the crowd, you'll probably be overlooked in favour of a firm with a stronger presence.

It's no coincidence that certain brand names that dominated the North American market in the 1920s still are leaders today. The public gravitates towards familiar names and symbols that have become associated with quality and reliability. That's why companies spend millions of dollars nurturing their corporate images. They may research, design, market and protect a name, logo or package design as much as the physical product itself.

A key way of protecting your corporate identity is through a registered trade-mark. Registration of your trade-mark is legal title to intellectual property in much the same way as a deed is title to a piece of real estate. It verifies the exclusive right you have established through use of a word, symbol, style or combination of these (a more complete definition follows under the heading "What is a trade-mark?"). Whether you are just starting out on a business venture or have been in the field for a long time, it pays to know about trade-marks. It's part of working strategically in a

fast-paced world.

### Purpose of this guide

In this booklet, we will look at what trade-marks are, how they can benefit you and how to register one. With a basic knowledge of the trade-mark concept and process, you can take steps to protect your intellectual property and avoid infringing the rights of others. This may help you steer clear of costly and time-consuming legal battles.

Keep in mind that this booklet offers general information only and does not cover all the complex issues that may arise through the registration process. This guide is not a substitute for an experienced trade-mark agent, nor does it provide authoritative definitions and explanations, for which the reader is referred to the *Trade-marks Act*, the *Trade-marks Regulations* (1996) and decisions of the Trade-marks Opposition Board and the courts. However, even if you are hiring a trade-mark agent, this guide can help you become a well-informed client.

Consult the Act, the Trade-marks Office or a trade-mark agent for more detailed information.

### The Trade-marks Office

The federal agency responsible for registering trade-marks in Canada is the Trade-marks Office, directed by the Registrar of Trade-marks.

The Trade-marks Office is part of a larger agency called the Canadian Intellectual Property Office (CIPO), which is part of Industry Canada. CIPO is responsible for other forms of intellectual property as well: namely, patents, copyrights, industrial designs and integrated circuit topographies.

The main functions of the Trade-marks Office are to:

- receive and examine applications for trade-mark registration and grant registrations to qualifying applicants;
- record and index trade-marks;
- approve and record assignments of trade-marks
- maintain an electronic inventory of trade-mark registrations and pending marks and a search room of these records for public use;
- provide general information to the public about the trade-mark registration process;
- publish the *Trade-marks Journal*; and
- maintain a list of trade-mark agents.

### Visit CIPO's Web site

CIPO's Web site includes useful information about its product lines, services and legislative changes. The five intellectual property guides are available, as are interactive tools that explain intellectual property in an

## THE BASICS

enjoyable way. You may visit our Web site at the following address: [www.cipo.gc.ca](http://www.cipo.gc.ca)

Find out more on how to fill and submit your trade-mark application on-line (see page 9 for more details).

### What is a trade-mark?

A trade-mark is a word, a symbol or a design (or a combination of these features) used to distinguish the wares or services of one person or organization from those of others in the marketplace. Trade-marks come to represent not only actual wares and services, but the reputation of the producer. As such, they are considered valuable intellectual property. A registered trade-mark can be protected through legal proceedings from misuse and imitation.

There are three categories of trade-marks:

- 1 **Ordinary marks** are words or symbols (or a combination of these features) that distinguish the wares or services of a specific firm or individual. Suppose you opened a courier business which you called "Giddy-up." You could register the words as a trade-mark (assuming all legal requirements were met) for the service you offer.
- 2 **Certification marks** identify wares or services which meet a defined standard. They are owned by one person but licensed to others to identify wares or services which meet a defined standard. Examples are: the Woolmark design owned by Woolmark Americas, Ltd., for use on

clothing and other wares and the logo of the Association of Professional Engineers.

- 3 **Distinguishing guise** identifies the shaping of wares or their containers, or is a mode of wrapping or packaging wares. If you manufactured candy moulded to look like butterfly flies, you might want to register the butterfly shape as a trade-mark under "distinguishing guise."

### Other forms of intellectual property

People occasionally confuse trade-marks with copyright, industrial designs, patents and integrated circuit topographies. These are rights granted for intellectual creativity and are also forms of intellectual property.

- **Patents** cover new inventions (process, machine, manufacture, composition of matter), or any new and useful improvement of an existing invention.
- **Copyrights** provide protection for literary, artistic, dramatic or musical works (including computer programs), and three other subject-matter known as: performance, sound recording and communication signal.
- **Industrial designs** are the visual features of shape, configuration, pattern or ornament (or any combination of these features) applied to a finished article of manufacture.

- **Integrated circuit topographies** refer to the three-dimensional configuration of the electronic circuits embodied in integrated circuit products or layout designs.

### Trade name vs. trade-mark

A trade name is the name under which you conduct your business, whether it be your own name, or the name of a corporation or a partnership or a name adopted for a segment of that business, i.e., a division of a company. The trade name can be registered under the *Trade-marks Act* only if it is also used as a trade-mark, that is, used to identify wares or services.

For instance, let's say you own an ice cream business and your company is called A.B.C. Ltd.:

*Example 1:* People know your ice cream under the name A.B.C. because you use it as a trade-mark on or in association with your ice cream. You can, therefore, register A.B.C. as a trade-mark.

*Example 2:* People know your ice cream under the word you have promoted — for example, "Northpole." Even though the official name of your company is A.B.C. Ltd., no one associates it with your wares. Therefore, A.B.C. cannot be considered a trade-mark unless you begin to use it as one.

In certain circumstances, a trade-mark registration may be declared invalid because of the

prior use in Canada of a trade name which is similar to the registered mark. Ideally, you should conduct a search of existing trade names before filing a trade-mark application. To do this, you can consult a variety of sources, including the NUANS (Newly Updated Automatic Name Search) database. A search of trade names or company names appearing in telephone directories from cities across Canada is also appropriate. To ensure a thorough search, it is best to hire a trade-mark agent to do the job.

#### **Registered trade-mark vs. unregistered trade-mark**

A registered trade-mark is one that is entered on the Trade-marks Register. You are not required to register your trade-mark — using a mark for a certain length of time can establish your ownership through Common Law — but it is highly recommended.

You must, however, apply for registration of a mark for precious metals. Your filing receipt is necessary if your goods must pass through customs.

Registration of your trade-mark gives you the exclusive right to use the mark across Canada for 15 years, renewable every 15 years thereafter. If you wish to apply for a trade-mark in other countries, you must apply to the country in which you seek registration.

Registration is *prima facie* evidence of your ownership. In a dispute, the registered owner does not have to prove

ownership; the onus is on the challenger. Use of an unregistered trade-mark can lead to a lengthy, expensive legal dispute over who has the right to use it.

Keep in mind also that a registered trade-mark is a valuable asset for business expansion through licensing franchises. Note as well that if you fail to use the mark for an extended period, your registration may be cancelled.

Consider this scenario: For the past five years you've been operating a highly successful ice cream emporium under the word "Northpole" in your home town in Nova Scotia. You've never heard of another Northpole and you have never bothered with trade-mark registration. Meanwhile, an Ontario firm has registered the trade-mark "Northpole" to identify its growing chain of spaghetti diners and home brand tomato sauce. While conducting research for a Maritime expansion plan, the Ontario firm discovers your store and serves you with a lawsuit. Depending on the facts established with the Court, this may result in a court order preventing you from using the word "Northpole." This development couldn't come at a worse time, since you were just planning to expand your own business. The situation could have been avoided if you had solidified your clear rights to the trade-mark through registration.

#### **Trade-mark agents**

Preparing a trade-mark application and following through on it

can be a complex task, particularly if a third party challenges your right to the mark. You may file on your own, but it is highly recommended that you hire a trade-mark agent to do so on your behalf.

In order to become a trade-mark agent, a Canadian resident must have worked in the field of trade-marks for at least 24 months, and have passed the qualifying examination.

A resident of Canada who is a barrister or solicitor, or a notary in the Province of Quebec, may become a trade-mark agent by passing the qualifying examination or working in the area of trade-mark law for at least 24 months.

An experienced, competent trade-mark agent who is well-briefed can save you problems caused by such obstacles as a poorly-prepared application or inadequate research. If you intend to register marks in other countries, the use of a trade-mark agent is strongly recommended.

You can find a list of trade-mark agents on CIPO's Web site. However, the Trade-marks Office cannot recommend any particular agent to you. Your local telephone directory is another source of agents' names.

Once you've appointed an agent, the Trade-marks Office will correspond with no one else about your application. You may, however, change agents at any time.

### **Who can register a trade-mark?**

Companies, individuals, partnerships, trade unions and lawful associations may obtain registration of their marks of identification for wares or services, provided they meet the requirements of the *Trade-marks Act* and Regulations.

### **How do I register my trade-mark?**

You can register a trade-mark electronically by filing an application for registration on-line with the Trade-marks Office in Gatineau, Quebec. Your application then goes through a stringent examination process to make sure that it meets all requirements of the *Trade-marks Act*. Keep in mind that in most instances your trade-mark must be used in Canada before it can be registered. While your application may be based on "proposed use," you must put your trade-mark into use before registration can occur.

In the following pages, we will outline the steps towards registration.

### **How much does it cost?**

The basic federal government costs are:

An application for the registration of a trade-mark:

- (a) \$250 for each trade-mark applied for (non-refundable) where the application and fee are submitted on-line to the Office of the Registrar of

Trade-marks, via the Canadian Intellectual Property Web site.

- (b) \$300 (non-refundable) in any other case.

If your application is successful, there is a \$200 fee for the issuance of a certificate of registration.

These costs do not take into account the fees of an agent, if you are using one.

### **Five-step examination process**

When the Trade-marks Office receives your application, it does the following:

- 1 searches the trade-marks' records to find any other trade-mark that may come into conflict with the one you've submitted and, if one is found, informs you of it;
- 2 examines the application for compliance with the requirements of the *Trade-marks Act* and Regulations and informs you of requirements which are not met by the application;
- 3 publishes the application in the *Trade-marks Journal* which is issued every Wednesday and is available on CIPO's Web site;
- 4 allows time for opposition (challenges) to the application. Anyone may, upon payment of \$750, file a statement of opposition with the Registrar. After considering the evidence filed by either or both parties, the Registrar decides whether to refuse your application or reject the opposition. The parties are notified of the

decision and reasons why;

- 5 if no one files an opposition to your application, the mark is allowed. Upon payment of the \$200 registration fee and the filing of a declaration of use in the case of a proposed use of the trade-mark application, mark is registered.

### **How long does registration last?**

Your registration is valid for 15 years thereafter upon the payment of \$350

- (a) where the request and fee are submitted on-line to the Office of the Registrar of Trade-marks, via the Canadian Intellectual Property Office Web site;
- (b) \$400 in any other case.

Note, however, that your registration may be the subject of a section 45 proceeding before the Trade-marks Office or an expungement proceeding before the Federal Court of Canada (see "Expungement of a trade-mark registration" on page 11).

### **Foreign registration**

Registering your trade-mark with the Trade-marks Office protects your rights in Canada only. If you are selling wares or services in other countries, you should consider registration in each of those countries.

Contact a trade-mark agent or the embassy of the country in question for information on foreign registration.



## MAKING SURE YOUR TRADE-MARK CAN BE REGISTERED

Your trade-mark will qualify for registration as long as it does not conflict with Canada's

*Trade-marks Act*, which sets out the requirements for registration. Sections 9 through 12 of the Act deal with the kinds of marks you may not register. Become familiar with these restrictions, summarized on the next page. It will help ensure a successful application.

### Names and surnames

A trade-mark will not be registered if it is primarily your full name or surname, or that of another individual (e.g. John Doe or Jane Smith, Wong, Cohen). An exception to this rule is if you can prove that your wares or services have become known under the name "Smith" or "Wong" or "Cohen," so that the word now connotes more than a person's name or surname in the public's mind. There are numerous examples of personal names that have become associated with a food, drink, or other product and are now registered trade-marks.

Another exception is if the name or surname has meaning other than just as a name or surname, i.e., it is also a recognizable word. Suppose your last name were, in fact, "Brown." You could register the word for your ice cream business as long as there were no other reasons to disqualify it.

### Clearly descriptive

You may not register a word that clearly describes a feature of the wares or services. For example, "sweet" for ice cream, "juicy" for apples, and "perfectly clean" for dry cleaner services could not become registered trade-marks. All good apples could be described as "juicy" and all ice cream as "sweet"; these are inherent characteristics of the wares. If you were allowed to register these words, no other apple sellers or ice cream vendors could use them to promote their goods, which would be unfair. Again, if you can establish that "Sweet Ice Cream" has become so well known that people think of your product (and no one else's) when they hear the words, you might be able to register the trade-mark.

### Deceptively misdescriptive

A further restriction is if the mark is not clearly descriptive, but clearly misleading, or in the words of the Act, "deceptively misdescriptive." For example, you could not register "sugar sweet" for candy sweetened with artificial sweetener, and "air express" for a courier service that uses ground transportation.

### Place of origin

You may not register a word that clearly designates the place of origin of the wares or services, or that misleads the public into thinking that the wares come from a certain place if they do not. Thus, Paris Fashions, Atlantic Cod, Toronto Courier

Service, B.C. Wines, or Danish Furniture could not be registered for those particular wares and services. Allowing you to use place names as part of your trade-mark would be to give you a monopoly on a geographical term and be unfair to others. However, you conceivably could register the words "North Pole" for bananas, since no one would expect bananas to come from there.

### Disclaimers

A disclaimer is a statement indicating that the applicant does not claim exclusive rights for a certain word or words appearing in the trade-mark.

In this way, you can use clearly descriptive words in your trade-mark which are unregistrable on their own (as described above), with the understanding that you have no rights over them.

For example, the trade-mark Northpole Ice Cream (used as a trade-mark for the operation of an ice cream parlour) would require a disclaimer of the words "ICE CREAM" as these are words that are clearly descriptive of the character of the services and should therefore remain available for all to use within this field.

A disclaimer statement is entered on the application (usually the third paragraph) and in the case of the above example would read as follows: "The applicant disclaims the right to the exclusive use of the words ICE CREAM apart from the trade-mark as a whole."

Therefore, these words are still part of the trade-mark, but the applicant is not claiming exclusive rights for these specific words.

### **Words in other languages**

Words that constitute the name of the wares or services in another language — such as “gelato,” Italian for ice cream; “anorak,” Inuktitut for parka; or “Wurst,” German for sausage — cannot be registered.

### **Causing confusion**

Beware of words, symbols, sounds and ideas that suggest someone else's trade-mark. If it is confusingly similar to a registered trade-mark or a pending mark, it will be refused. This prohibition makes sense when you recall that the whole point of registering a trade-mark is to protect your corporate identity from imitation or confusion with others. Trade-mark examiners take into account various factors when determining whether trade-marks are confusing. For example, they determine:

- A** whether the trade-marks look or sound alike and whether they suggest similar ideas; and
- B** whether they are used to market similar wares or services.

Let's go back to the example of “Northpole” Ice Cream. Suppose another company was manufacturing and selling frozen water products under the registered trade-mark “Southpole.” People might easily conclude that

“Northpole” and “Southpole” products are manufactured and sold by the same company. They might expect the trade-marks to be owned by the same entity. Hence your application to register “Northpole” might be turned down on the grounds of causing confusion with the registered mark “Southpole” owned by another company.

Other hypothetical examples of confusing trade-marks would be: “King Dog Food” vs. “King Cat Food” (two companies, two different product lines, but the same trade-mark and the same general area — pet food); and “Glitter” mineral water vs. “Glittering” ginger ale. However, “Glitter” for mineral water could probably coexist as a registered trade-mark with “Glittering Dry Cleaners” as a registered trade-mark for dry cleaning services, because the wares and services in this example are quite different.

### **Prohibited marks**

Subsection 9(1) of the *Trade-marks Act* lists various kinds of marks that are expressly prohibited. You may not register a trade-mark that resembles certain official symbols unless you have the consent of the authority in question. These official symbols include:

- official government symbols, e.g., the Canadian flag;
- coats of arms of the Royal Family;
- badges and crests of the

Armed Forces and the letters R.C.M.P.;

- emblems and names of the Red Cross, the Red Crescent, the United Nations;
- armorial bearings, flags and symbols of other countries; and
- symbols of provinces, municipalities and public institutions.

These prohibitions are designed to prevent people from “cashing in” on the prestige and authority of the above-mentioned institutions and misleading the public.

Subsection 9(1) of the *Trade-marks Act* also prohibits subject matter that is obscene, scandalous or immoral. For example, your trade-mark may not include profane language, obscene visuals or racial slurs.

Another prohibition covers the use of portraits or signatures of living persons or persons who have died within the preceding 30 years. For example, using the photo of an existing rock group to promote your record store would be prohibited unless you had formal consent to do so.

### **Further prohibitions**

A trade-mark will not be registered if it consists of a plant variety denomination or is a mark so nearly resembling a plant variety denomination as to be likely to be mistaken therefore, and the application covers the plant variety or another plant variety of the same species.

A trade-mark will not be registered if it is, in whole or in part, a protected geographical indication for wines or spirits, and the application covers a wine or spirit not originating in the territory

indicated by the geographical indication.

### **Summary: What trade-marks can you register?**

#### **No:**

- "Sweet" Ice Cream
- "Devonshire" Ice Cream (unless, in the above cases, you can prove that the trade-mark is distinctive of the applicant)
- "Northpole" Ice Cream (if "Southpole" is a registered trade-mark for frozen water products)
- "R.C.M.P.'s Favorite" Ice Cream

#### **Yes:**

- "Northpole" Ice Cream (if it is not confusing with a registered or entitled pending trade-mark, i.e., one with an earlier date of filing)
- "Venus" Ice Cream (mythical, not actual name)
- "Scrumptillus" Ice Cream (invented, not real adjective)
- "True Blue" Ice Cream (words not normally associated with ice cream)

*Note: In all the above cases, there would be a disclaimer covering the words "ice cream."*

## THE TRADE-MARK REGISTRATION PROCESS

### The preliminary search

#### The Trade-marks Office

The Trade-marks Office maintains a public electronic inventory of all registered trade-marks and pending applications in Gatineau, Quebec. Before you apply for trade-mark registration, you or your agent should conduct a thorough search of the electronic register and the Trade-marks Database to see if your trade-mark could be confused with someone else's. This step is not mandatory, but it is a good idea for two reasons:

- 1 It is a form of pre-screening. It will help you determine whether your application has a chance for success, or whether it would be a waste of time and money to try to register it in its present form. For example, your search may turn up a registered trade-mark "Southpole" for frozen water products, hence you would have trouble registering "Northpole" for your ice cream.
- 2 A search can help you avoid trade-mark infringement and potential lawsuits.

The search room in the Client Service Centre, in Gatineau, is open to the public, free of charge, from 8:30 a.m. to 4:30 p.m., Eastern Time, Monday through Friday, except on legal holidays, at:

Canadian Intellectual  
Property Office  
Place du Portage I  
50 Victoria Street  
2nd Floor  
Gatineau, Quebec K1A 0C9

You may personally visit the Trade-marks Office, or you may consult one of the companies licensed to use the electronic database, or hire a freelance

trade-mark searcher or a trade-mark agent to do the research job on your behalf. Freelance searchers and trade-mark agents are listed in your local telephone directory under "Searchers of Records" and "Trade-marks."

The Trade-marks Office' electronic inventory and the Trade-marks Database contain listings of registered and pending applications. The electronic indices cover word marks, slogans, numbers, pictures and combinations of these. As soon as your application is received, it too becomes part of the public record and is subject to inspection by the public.

To conduct a proper search, you will have to check for various possible versions of the mark. In the case of a word mark, you should look for all conceivable spellings. For example, if your trade-mark is "Northpole" you search for "North," "Nord" and "Pole."

Also in the Office records are samples of crests, badges and official symbols that fall into the category "Prohibited Marks," under subsection 9(1) of the *Trade-marks Act*. These samples can help you verify that your trade-mark does not fall into a prohibited category.

You should allow at least half a day to conduct your search. An information officer in the Client Service Centre will be pleased to explain how to access the electronic register and to provide you with general information about the *Trade-marks Act* and Regulations. Remember, the Trade-marks Office cannot conduct the search for you, or advise you on whether your mark is registrable. This can only

happen in the examination process for a filed trade-mark application.

#### Trade names

Consider also having a search of trade names done before you go any further. Trade names are often also used as trade-marks, even if they are not registered as such. Southpole Inc. may never have filed for trade-mark registration, but if the name "Southpole" is known for frozen water products, the company could argue ownership of the word as a trade name, as well as a trade-mark. Southpole Inc. could not prevent you from filing your "Northpole" application. The Trade-marks Office would not have "Southpole" on its trade-mark records, because trade names are not registered with it.

However, Southpole Inc. could easily find out about your application, either by doing a search of the Trade-marks Office records or when your application is published in the *Trade-marks Journal*. It may then challenge your application during the stage called "Opposition."

As trade names may be recorded separately in each province under provincial legislation, there is no complete central inventory containing all current names, although through NUANS you can access a database of registered corporate names. This search is therefore quite complex and you are advised to hire a trade-mark agent to do the job for you.

#### Application

The principal document in the registration process is your application form. You must file a separate application for each

trade-mark you wish to register, although one application may cover both wares and services or a number of wares or services. You create the form yourself based on the sample formats supplied with this guide. There are a total of nine different suggested formats, covering every kind of application (e.g. ordinary marks, certification marks, applications for amendment of a registration, etc.). For your convenience, the most commonly used formats, 1 and 4, annotated with instructions for filling them out, are included as Appendix B.

**Electronic copies of the suggested formats are available on our Web site in PDF (Portable Document Format). Trade-mark applications may also be filed electronically from our Web site using the Trade-marks Office On-line Electronic Filing System.**

- **Format 1** is for applications for ordinary marks based on use in Canada. This means you have been using the mark for a certain length of time and your claim is based on this fact.
- **Format 4** is for applications for ordinary marks based on proposed use in Canada. This means that you state your intention to use the mark as described in your application. (You must demonstrate "use" before registration can occur.) You should consider waiting until the opposition period is over before commencing use of your mark.

If appropriate, you could combine the two formats. For example, if you've been offering a restaurant service under the name "Northpole" for several

years and now you plan to also sell "Northpole" ice cream, your application would be based on both "use for the services" and "proposed use for the wares." Whichever format you use, you must specify the trade-mark you are seeking to register. If your trade-mark is anything other than a word or words in upper or lower case letters or includes French or English punctuation, then a drawing of the design is required at the time you file the application.

The formal drawing should:

- be in black and white; and
- include a description of the colour(s) if colour is claimed by you in the trade-mark.

For detailed designs, a drawing as large as possible, but not exceeding 22 cm x 35 cm (8.5 inches x 14 inches), will allow for the clearest reproduction.

If you wish, you may use the special chart in the *Trade-marks Regulations* (1996) to indicate your colours. But note that including colour gives you less flexibility, as you must then always use your trade-mark in those specified colours. If you simply present your design in black and white, you will be free to use the mark in any colour. Likewise, presenting your word mark in any style of lettering other than upper or lower case restricts you. If you wish maximum flexibility, present the word mark in upper or lower case and the design in black and white.

To sum up, a complete application includes:

- 1 the appropriate application form filled out by you or your agent;
- 2 the application fee; and
- 3 a formal drawing where

appropriate.

## Foreign applicants

If you are applying for registration of a trade-mark in Canada, but reside in a country other than Canada, you must appoint a representative for service to whom the Office correspondence will be directed.

## Filing date

When your application arrives at the Trade-marks Office, the staff check it to make sure it is complete. If anything is missing, they will contact you to ask for documents or information. Once this process is finished, the Office will acknowledge receipt of a completed application and assign a filing date, that is, the date that your application is officially filed. (Do not confuse this date with registration.) This filing date is particularly important since it is the date used to assess entitlement to registration at the examination stage.

After the formal filing, you may make minor modifications in your application. Major changes, however, would entail the trouble and expense of another filing. For example, you may limit or specify the wares and/or services made in your initial application but you cannot extend your initial identification of wares and/or services. To avoid this, you or your agent must take great care in preparing your application.

## Search and research

Trade-marks Office staff conduct a thorough search of the records to verify that your trade-mark cannot be mistaken for anyone else's. They will also determine whether your mark fulfils all the criteria of the *Trade-marks Act*, in other words, that it does not

fall into any of the categories discussed in the section, "Making sure your trade-mark can be registered." The results are considered by the Trade-marks Examiner assigned to your case.

### **Examination**

The Examiner studies the data and decides whether your application can be accepted. If there are doubts about your case, the Examiner will notify you of the objections. You then have opportunities to respond. If your answers still fail to satisfy the Examiner, you will receive a letter informing you that your application has been refused and explaining the reasons why. In the event of refusal, you have the right to appeal to the Federal Court of Canada.

### **Disclaimers**

The Examiner may request that the applicant disclaim the right to the exclusive use, apart from the trade-mark, of a portion of the trade-mark if the appropriate disclaimer statement has not already been included in the application.

### **Abandonment**

If you fail to prosecute your application (take all the steps necessary to complete the process), your application may be considered abandoned. Before this happens, you will be notified and given an opportunity to remedy the situation within a specified time period. If you do not respond appropriately, your application will be considered abandoned and you will have to re-apply with the requisite fee to pursue the trade-mark.

### **Pre-publication search**

Let's suppose your application

for the trade-mark "Northpole" has been approved for advertisement in the *Trade-marks Journal*. The Examiner could find no grounds to disqualify it. Does that mean registration is completed? No. There are still hurdles to overcome. The Office does another search, called Pre-publication Verification, to ensure that in the intervening months, no one has registered or applied for registration of a trade-mark that conflicts with yours. The Office will again correspond with you if necessary and seek your comments on any such trade-mark.

### **Advertisement**

Suppose the Pre-publication Verification has not unearthed any new objections for "Northpole." Now your application is ready for advertisement in the *Trade-marks Journal*. This journal, published each Wednesday, contains details about every application which has been approved for advertisement. When an application is advertised, it allows members of the public an opportunity to raise objections to pending applications prior to registration. It is another means of weeding out trade-marks that conflict with those of other owners. The Journal entry for "Northpole" is a summary of the information on the trade-mark and includes your name, address, file number, filing date, the trade-mark (the word mark, symbols, etc.), whether it is based on "use" or "proposed use", which goods and services it is used for and any other claims (colour claims, disclaimers, etc.).

### **Opposition**

Any person with valid grounds for doing so may oppose a trade-mark application advertised in the

*Trade-marks Journal*. An opposition must be made within two months of the publication date by either filing a statement of opposition together with a fee of \$750, or by requesting an extension of time to oppose, with a fee of \$125. The Trade-marks Office will dismiss an opposition it considers to be frivolous.

If your application is opposed and you don't already have an agent, you are urged to hire one at this point. The same holds true if you wish to oppose someone else's application. Opposition is a complex adversarial process, much like a court proceeding, during which both parties may file evidence and counter-arguments, cross-examine the evidence of the other party and make representations at an oral hearing. The whole procedure can take as long as two to four years, sometimes longer. After a final decision is rendered, it may be appealed to the Federal Court of Canada. Because opposition proceedings can absorb so much time and money, you are advised to choose your trade-mark agent carefully. Seek someone who has a proven expertise in the field.

### **Allowance and registration**

If there is no opposition, or if an opposition has been decided in your favour, your application will be allowed. The Trade-marks Office will not consider any further challenges. You will receive a Notice of Allowance and be asked to pay the \$200 registration fee. If your application has been based on "proposed use," you will be asked for a declaration stating you have commenced use of the trade-mark. The final step, after you have fulfilled these requirements, is for the Office to issue a Certificate of Registration and enter the registration on its records.



## OTHER PROCEDURES

### Expungement of a trade-mark registration

The registration of a trade-mark provides the registered owner with a very valuable right, namely, the exclusive right to the use throughout Canada of the trade-mark in respect of the registered wares and/or services. However, in order to keep such a right, the registered owner must fulfill some responsibilities.

One responsibility is that the registered owner must pay a renewal fee every 15 years. Failure to pay such a fee on time will result in the expungement of the trade-mark registration.

Another responsibility of the owner is to use the trade-mark in Canada. If the trade-mark is not in use, then the registration is liable to be expunged either by the Registrar or by the Federal Court. Summary expungement proceedings may be instituted by the Registrar either of his own volition at any time during the life of the registration, or at the request of a third party upon payment of the prescribed fee, after three years from the date of the registration (see section 45 of the *Trade-marks Act*). The procedure before the Registrar begins when the Registrar issues a notice to the registered owner asking him to furnish evidence showing use of the trade-mark in Canada or special circumstances excusing non-use. The registered owner must furnish evidence, since failure to reply to the Registrar's notice will result in the expungement of the trade-mark registration.

**IMPORTANT** — The notice will be issued to the registered owner and his representative for service at the addresses shown on the registration page. Please note that if you have failed to notify the Registrar of a change of address, the Registrar is not responsible for any correspondence not received by the registrant or its representative for service or its agent.

Once the Registrar has received the evidence, the registered owner and the requesting party have an opportunity to submit written arguments and to make representations at an oral hearing. The whole procedure can take as long as one and a half to two years. After a final decision is rendered to either expunge, amend or maintain the registration, it may be appealed to the Federal Court of Canada.

In view of the complicated nature of section 45 proceedings, the parties are advised to use the services of a registered trade-mark agent.

For more information, refer to section 45 of the *Trade-marks Act*, or call (819) 997-7300.

### Assignment

A trade-mark is a form of property. You can sell, bequeath or otherwise transfer your rights to it to another party through a transaction called an "assignment." You should formally notify the Trade-marks Office of such changes in ownership so that the Office can amend its records accordingly. This is done to avoid ownership disputes.

There are no prescribed forms for notifying the Trade-marks Office of an assignment, but you must send evidence of the change, together with the prescribed fee.

Other transactions can affect the ownership of a trade-mark, for example a change of name, a merger, etc.

### Marking requirements

Canada's *Trade-marks Act* does not contain any marking requirements. However, trade-mark owners often indicate their registration through certain symbols, namely, R in a circle (registered), TM (trade-mark), SM (service mark), MD (marque déposée) or MC (marque de commerce).

Although the Act does not require the use of these symbols, it is advisable to use them. The symbols TM, SM or MC may be used regardless of whether the trade-mark is registered. The R in a circle, or MD, on the other hand, should be used only if the mark is registered.

Canada's *Precious Metals Marking Act* states that you must file a trade-mark application for the trade-mark used on the wares, if you wish to stamp a quality mark (e.g. 10K gold) on your product. The quality mark itself is not mandatory.

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### **Policing your trade-mark**

One of the functions of the Trade-marks Office is to prevent anyone else from registering a mark that is the same as or confusingly similar to your mark. It does not, however, keep an eye out for cases of infringement. It is your responsibility entirely to monitor the marketplace and, if you find someone using your registered trade-mark or a mark or a trade name that is confusing with your mark, to take legal action. Someone who infringes on trade-mark rights may be accountable to you by way of an injunction, i.e., an order to cease the infringing activity and/or damages.

Preventing imitation by competitors is not the only reason to police your mark. If your business is a smash success, your mark may be in danger of becoming a generic term. Believe it or not, too much familiarity can be a bad thing.

If consumers start saying "Northpole" when they mean any ice cream, your trade-mark may no longer be distinguishable from others. Such was the fate of trade-marks such as "Zipper," "Escalator," "Cellophane," and "Dry Ice." Who remembers that the correct terms are "slide fastener" and "moving staircase"? This is why some companies are very vigilant about policing their marks, and preventing improper use of their trade-marks in any kind of communication.



## FOR MORE INFORMATION

Information officers at the Trade-marks Office can assist you with questions about trade-marks. Address your correspondence to:

Trade-marks Office  
Canadian Intellectual  
Property Office  
Industry Canada  
Place du Portage I  
50 Victoria Street  
Gatineau, Quebec K1A 0C9

or telephone the Client Service Centre at (819) 997-1936 between 8:30 a.m. and 4:30 p.m., Eastern Time, Monday through Friday, except on statutory holidays.

To help the Office help you, please refer to your file number (if and when you receive one) in all your written and telephone communications. Other useful references to include would be: trade-mark registration numbers and, in the case of an opposition, the date the relevant trade-mark application appeared in the *Trade-marks Journal*, together with the file number of the application.

Copies of various documents referenced in this guide, including the *Trade-marks Act* and *Trade-marks Regulations*, the *Trade-marks Examination Manual* and the *Trade-marks Wares and Services Manual*, are available from our Web site, free of charge. For a fee, paper copies may be obtained by contacting:

Canadian Government  
Publishing  
Public Works and  
Government Services  
Canada  
Ottawa, Ontario K1A 0S9

Tel.: (819) 956-4802  
Fax: (819) 994-1498

Mail intended for the Office of the Registrar of Trade-marks and delivered:

- 1** during business hours to CIPO Headquarters in Gatineau, will be accorded the date of receipt that day;
- 2** during business hours to Industry Canada Headquarters or to one of its regional offices, will be accorded the date of receipt in that office\*;
- 3** at any time by facsimile transmission (all mail) or the Internet (new applications only), will be considered to be received on the day that it is transmitted if received before midnight, local time, at the Office of the Registrar of Trade-marks in Gatineau\*;
- 4** through Canada Post Corporation's (CPC) Registered Mail Service, will be considered to be received on the date stamped on the envelope by CPC\*.

\*Only if it is a day on which CIPO Headquarters in Gatineau is open, if not, it will be considered to be received on the next working day.

## TARIFF OF FEES

The following table presents all the possible application, registration and service fees.

Please note that payments may be made by credit card (VISA, MasterCard or American Express), deposit account, postal money order or cheque payable in Canadian dollars to the Receiver General for Canada. Do not add federal and provincial taxes.

### PART I On the filing of:

- 1** An application for registration of a trade-mark.  
(a) where the application and fee are submitted on-line to the Office of the Registrar of Trade-Marks, via CIPO's Web site.....\$250  
(b) in any other case.....\$300
- 2** A statement of opposition pursuant to subsection 38(1) of the Act.....\$750
- 3** An application to amend the registration of a trade-mark by extending the statement of wares or services in respect of which the trade-mark is registered.....\$450
- 4** (Repealed, SOR/2003-209, s. 4)
- 5** Any other application to amend the register, other than corrections of clerical errors and amendments of the name, address or description of the representative for service in Canada, for each trade-mark.....\$50
- 6** A request to recognize the transfer of one or more trade-marks, for each

trade-mark.....\$100

- 7** A request to renew the registration of one or more trade-marks,  
(a) where the request and fee are submitted on-line to the Office of the Registrar of Trade-Marks, via CIPO's Web site.....\$350  
(b) in any other case.....\$400

- 8** A request to send one or more notices pursuant to section 44 or 45 of the Act, for each notice.....\$400

- 9** An application for an extension of time pursuant to subsection 47(1) or (2) of the Act, for each act.....\$125

- 10** Each certified copy of a registration referred to in subsection 31(1) of the Act.....\$50

- 11** (Repealed, SOR/2003-209, s. 6)

- 12** A request pursuant to paragraph 9(1)(n) or (n.1) of the Act with respect to one or more badges, crests, emblems, marks or armorial bearings:  
for each badge, crest, emblem, mark or armorial bearing.....\$500

- 13** A request for the transmission of documents to the Federal Court of Canada pursuant to subsection 60(1) of the Act, for each file.....\$175

- 14** A statement of objection pursuant to subsection 11.13(1) of the Act .....\$1000

### PART II For the registration of:

- 15** A Trade-mark, including, without further fee, the issuance of a certificate of registration of the Trade-mark.....\$200

### PART III On the issuance of:

- 16** A certified copy in paper form of a document:  
(a) for each certification.....\$35  
(b) plus, for each page.....\$1
- 17** A certified copy in electronic form of a document:  
(a) for each certification.....\$35  
(b) plus, for each trade-mark to which the request relates.....\$10
- 18** A copy in paper form of a document, for each page,  
(a) where the person requesting makes the copy using equipment of the Office of the Registrar of Trade-marks.....\$0.50  
(b) where the Office makes the copy.....\$1
- 18.1** A copy in electronic form of a document:  
(a) for each request.....\$10  
(b) plus, for each trade-mark to which the request relates.....\$10  
(c) plus, if the copy is requested on a physical medium, for each physical medium requested in addition to the first.....\$10

### PART IV Trade-mark agents:

- 19** On request, to enter a name on the list of trade-mark agents:  
(a) where the request and fee are submitted on-line to the Office of the Registrar of Trade-Marks, via CIPO's Web site.....\$300  
(b) in any other case.....\$350
- 20** Examination fee referred to in paragraph 20(2)(b).....\$400
- 21** Annual registration fee referred to in paragraphs 22(1)(a) and (2)(b):  
(a) where the fee is submitted

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on-line to the Office of the  
Registrar of Trade-Marks, via the  
Canadian Intellectual Property  
Office Web site.....\$300  
(b) in any other case.....\$350  
**22** Reinstatement fee referred  
to in paragraph 23(1)(b).....\$200

## APPENDIX A — FREQUENTLY ASKED QUESTIONS

### **Q1** What is a trade-mark?

**A** A trade-mark is a word, symbol or design, or a combination of these, used to distinguish the goods or services of one person or organization from those of others in the marketplace.

### **Q2** Are there different kinds of trade-marks?

**A** Yes, there are three basic types. **Ordinary marks** are words and/or symbols that distinguish the goods or services of a specific firm. **Certification marks** identify goods or services which meet a standard set by a governing organization. **Distinguishing guise** identifies the shaping of wares or their containers, or a mode of wrapping or packaging wares.

### **Q3** What is the difference between trade-marks and other forms of intellectual property?

**A** Trade-marks are only one form of intellectual property that can be protected through federal legislation. The other forms are: **patents**, for new technologies; **copyrights**, for literary, artistic, dramatic or musical works, performance, sound recording or communication signal; **industrial designs**, for the shape, pattern, or ornamentation applied to an industrially produced object; and **integrated circuit topographies**, for the three-dimensional configuration of the electronic circuits embodied in integrated circuit products or layout designs.

### **Q4** What is the difference between a registered and an unregistered trade-mark?

**A** A registered trade-mark has been approved and entered on the Trade-marks Register held by the Trade-marks Office. Registration is proof of ownership. An unregistered trade-mark may also be recognized through Common Law as the property of the owner, depending on the circumstances.

### **Q5** Why register a trade-mark?

**A** Registration is direct (*prima facie*) evidence of exclusive ownership across Canada and helps ward off potential infringers. It enables you to more easily protect your rights should someone challenge them since the onus is on the challenger to prove rights in any dispute. The process of registration, with its thorough checks for conflicting trade-marks, will ensure that you are claiming a unique mark, and help you avoid infringement of other parties' rights. A registered trade-mark is a prerequisite for franchising a business.

### **Q6** Is registration mandatory?

**A** No, but it is advisable.

### **Q7** Why hire a trade-mark agent?

**A** Trade-mark registration can be a complex process; an experienced agent can save you time and money by avoiding pitfalls such as poorly prepared applications and improper research.

### **Q8** Who can register a trade-mark?

**A** Companies, individuals, partnerships, trade unions or lawful associations, provided they meet the requirements of the *Trade-marks Act*.

### **Q9** How long is registration effective?

**A** Registration is valid for 15 years and is renewable every 15 years afterwards upon payment of a fee.

### **Q10** How do I register a trade-mark?

**A** You must file an application with the Trade-marks Office in Gatineau, Quebec. The application undergoes stringent examination to ensure it meets the requirements of the *Trade-marks Act*.

### **Q11** Does registration in Canada protect my rights in other countries?

**A** No. If your products are sold in other countries, you should consider applying for foreign registration. Contact a trade-mark agent or the embassy of the country in question to find out about procedures.

### **Q12** What is the difference between a trade-mark and a trade name?

**A** A trade name is the name under which you conduct your business. It can be registered as a trade-mark, but only if it is used as such, that is, used to identify wares or services.

**Q13** *May I register my own name as a trade-mark?*

**A** Normally, you may not register a proper name — neither yours, nor anyone else's — as a trade-mark. An exception may be made if you can demonstrate that the name has become identified in the public mind with certain wares or services.

**Q14** *What other kinds of marks may not be registered?*

**A** In general, the following marks may not be registered: words that are clearly descriptive (e.g. "delicious" ice cream), terms that are misleading, words that designate a place of origin (e.g. "Atlantic" cod), terms or symbols that are too similar to an existing trade-mark, and terms and symbols that are expressly prohibited under the *Trade-marks Act*. These latter include symbols (coats of arms, badges, crests, etc.) of national and international organizations and terms that are considered immoral or offensive. Other types of marks which may not be registered are plant variety denominations and protected geographical indications for wines and spirits.

**Q15** *What are the steps of trade-mark registration?*

**A** Trade-mark registration usually involves:

- 1) a preliminary search (done by you or your agent) of existing trade-marks;
- 2) an application;
- 3) an examination of your application by the Trade-marks Office;
- 4) publishing of the application in the *Trade-marks Journal*;
- 5) time for opposition

(challenges) to the application; and  
6) allowance and registration (if there is no opposition).

**Q16** *Why is the preliminary search important?*

**A** It helps you determine whether your application has a chance for success. It helps you avoid infringing on other people's trade-marks.

**Q17** *Will the Trade-marks Office tell me during my preliminary search if my trade-mark can be registered?*

**A** No, the Office cannot provide a judgment at this stage. This can only happen during the examination process. Officials will give you general information about the rules and regulations.

**Q18** *What do I need to include in my application?*

- A**
- 1) the appropriate, completed application form;
  - 2) the application fee; and
  - 3) a drawing of the trade-mark if the application is made for a word or words in special form or a design.

**Q19** *May I allow other parties to use my registered trade-mark?*

**A** Yes. You may sell, bequeath or otherwise transfer your rights to a trade-mark through a process called assignment. You may also license rights to your trade-mark.

**Q20** *Will the Trade-marks Office ensure that my trade-mark is not infringed?*

**A** The Trade-marks Office does not act as an enforcement agency. You are responsible for monitoring the marketplace for cases of infringement and taking legal action, if necessary.

**Q21** *Should I incorporate my company?*

**A** The answer to this question depends on your company's situation. Corporations Canada publishes the *Small Business Guide to Federal Incorporation* which can help you decide if you should incorporate federally. You may also choose to incorporate at the provincial level. Please consult the appropriate provincial government's Web site for further details on provincial incorporation (links available on the Corporations Canada Web site in the Other related links section).

## APPENDIX B — FORMAT OF THE APPLICATION

**PLEASE NOTE THAT OUR OFFICE DOES NOT SUPPLY FORMS. IT IS THE RESPONSIBILITY OF THE APPLICANTS TO FOLLOW THE APPROPRIATE FORMAT AND STRUCTURE THEIR OWN FORM.**

THE FOLLOWING FORMS MAY BE USED, WHERE APPROPRIATE, FOR THE SUBMISSION OF INFORMATION TO THE REGISTRAR OF TRADE-MARKS. THE USE OF THESE FORMS IS NOT MANDATORY. THE REGISTRAR WILL ACCEPT ALTERNATIVE FORMATS, PROVIDED THAT ALL INFORMATION REQUIRED BY THE *TRADE-MARKS ACT* OR REGULATIONS IN THE PARTICULAR CIRCUMSTANCE IS GIVEN.

### Instructions for Format 1

- (A) (i) In the case of a corporation, give full name.  
(ii) In the case of an individual, give the surname and at least one given name. If the individual trades under a name other than his own name, follow his name by the words "trading as" then give the trading name.  
(iii) In the case of a partnership, give the surname and at least one given name for each partner. Follow these names with either the words "a partnership" or the words "trading as" and then give the name under which the partnership trades.
- (B) Every address required to be furnished shall be a complete post office address and should include a street name, number and a postal code where one exists.
- (C) (i) If the trade-mark is a word or words not depicted in a special form, set out the word or words in upper or lower case letters.  
(ii) If the trade-mark is a design, insert the phrase "shown in the accompanying drawing" and annex the drawing (see **Application** section of this guide) to the form.
- (D) If all the specific **wares** in association with which the trade-mark has been used in Canada, and in respect of which registration is requested, fall into a single general class, list them all here. If such wares fall into more than one general class, list here only those falling into one class. The wares must be described in ordinary commercial terms.
- (E) Give the earliest date when the applicant began to use the trade-mark in Canada in association with any of the wares listed in accordance with (D).
- (F) List here the specific wares in accordance with which the trade-mark has been used in Canada, and in respect of which registration is requested, which fall into a different general class from that comprising the wares listed in accordance with note (D).
- (G) Give the earliest date when the applicant began to use the trade-mark in Canada in association with any of the wares listed in accordance with note (F).
- (H) If the trade-mark has been used in Canada in association with the specific wares falling into further different general classes, repeat here the words "and in association with the general class of wares comprising the following specific wares..." as often as necessary, listing in each case the specific wares falling into the different general class from those comprising the previously listed, and giving in each case the earliest date when the applicant began to use the trade-mark in Canada in association with any of such wares.
- (I) If all the specific **services** in association with which the trade-mark has been used in Canada, and in respect of which registration is requested, fall into a single general class, list them all here. If such services fall into more than one general class, list here only those falling into one general class. The services must be described in ordinary commercial terms.
- (J) Give the earliest date when the applicant began to use the trade-mark in Canada in association with any of the services listed in accordance with note (I).
- (K) List here the specific services in accordance with which the trade-mark has been used in Canada, and in respect of which registration is requested, which fall into a different general class from that comprising the services listed in accordance with note (I).
- (L) Give the earliest date when the applicant began to use the trade-mark in Canada in association with any of the services listed in accordance with note (K).
- (M) If the trade-mark has been used in Canada in association with specific services falling into further different general classes, repeat here the words "and in association with the general class of services comprising the following specific services..." as often as necessary, listing in each case the specific services falling into the different general class from those comprising the previously listed, and giving in each case the earliest date when the applicant began to use the trade-mark in Canada in association with any such services.
- (N) Insert "wares", "services" or "wares and services" as applicable.

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**Format 1**

**Application for Registration of a Trade-mark in use in Canada**

To: The Registrar of Trade-marks, Gatineau, Canada.

The applicant \_\_\_\_\_ (A) \_\_\_\_\_ whose full post office address of its principal office or place of business is \_\_\_\_\_

\_\_\_\_\_ (B) \_\_\_\_\_

applies for the registration, in accordance with the provisions of the *Trade-marks Act*, of the trade-mark identified below.

The trade-mark is the word(s) (or is shown in the attached drawing)

\_\_\_\_\_ (C) \_\_\_\_\_

The trade-mark has been used in Canada by the applicant in association with all the specific wares listed hereafter, and the applicant requests registration in respect of such wares. The trade-mark has been so used in Canada in association with the general class of wares comprising the following specific wares \_\_\_\_\_ (D) \_\_\_\_\_

\_\_\_\_\_ since \_\_\_\_\_ (E) \_\_\_\_\_

and in association with the general class of wares comprising the following specific wares

\_\_\_\_\_ (F) \_\_\_\_\_ since \_\_\_\_\_ (G) \_\_\_\_\_

The trade-mark has been used in Canada by the applicant in association with all the specific services listed hereafter, and the applicant requests registration in respect of such services. The trade-mark has been so used in Canada in association with the general class of services comprising the following specific services

\_\_\_\_\_ (I) \_\_\_\_\_ since \_\_\_\_\_ (J) \_\_\_\_\_

and in association with the general class of services comprising the following specific services

\_\_\_\_\_ (K) \_\_\_\_\_ since \_\_\_\_\_ (L) \_\_\_\_\_ (M) \_\_\_\_\_

The applicant is satisfied that he or she is entitled to use the trade-mark in Canada in association with the \_\_\_\_\_ (N) \_\_\_\_\_ described above.



### Instructions for Format 4

- (A) (i) In the case of a corporation, give full name.  
(ii) In the case of an individual, give the surname and at least one given name. If the individual trades under a name other than his/her own name, follow his/her name by the words "trading as" then give the trading name.  
(iii) In the case of a partnership, give the surname and at least one given name for each partner. Follow these names with either

the words "a partnership" or the words "trading as" and then give the name under which the partnership trades.

- (B) Every address required to be furnished shall be a complete post office address and should include a street name, number and a postal code where one exists.  
(C) (i) If the trade-mark is a word or words not depicted in a special form, set out the word or words in upper or lower case letters.  
(ii) If the trade-mark is a design, insert the phrase "shown in the

accompanying drawing" and annex the drawing (see **Application** section of this guide) to the form.

- (D) List all specific wares. The wares should be described in ordinary commercial terms.  
(E) List all specific services. The services should be described in ordinary commercial terms.  
(F) Insert "wares", "services" or "wares and services" as applicable.

### Format 4

#### Application for Registration of a Proposed Trade-mark

To: The Registrar of Trade-marks, Gatineau, Canada.

The applicant (A) \_\_\_\_\_ whose full post office address of its principal office or place of business is (B) \_\_\_\_\_

applies for the registration, in accordance with the provisions of the *Trade-marks Act*, of the trade-mark identified below.

The trade-mark is the word(s) (or is shown in the attached drawing) (C) \_\_\_\_\_

The applicant, by himself/herself or through a licensee, or by himself/herself and through a licensee, intends to use the trade-mark in Canada in association with (D) \_\_\_\_\_ and requests registration of the trade-mark in respect of such wares.

The applicant, by himself/herself or through a licensee, or by himself/herself and through a licensee, intends to use the trade-mark in Canada in association with (E) \_\_\_\_\_ and requests registration of the trade-mark in respect of such services.

The applicant is satisfied that he/she is entitled to use the trade-mark in Canada in association with the (F) \_\_\_\_\_ described above.



## APPENDIX C — YOUR TRADE-MARK APPLICATION

### Some common errors to avoid

You're ready to file your trade-mark application — but first, take some time to go through the following checklist. The following are some very common errors applicants make that result in delays in processing of the application.

- ✓ **Filing fee** — Remember, each application must be accompanied by:  
(a) \$250 for each trade-mark applied for (non-refundable) where the application and fee are submitted on-line to the Office of the Registrar of Trade-marks, via the Canadian Intellectual Property Web site;  
(b) \$300 (non-refundable) in any other case.  
Please note that payments may be made by credit card (VISA, MasterCard or American Express), deposit account, postal money order or cheque payable in Canadian dollars to the Receiver General for Canada. Do not add federal and provincial taxes.
- ✓ **Wares/services** — Make sure you include all the wares and/or services with which you intend to use, or have used, your trade-mark since you will not be permitted to extend your wares and/or services after filing the application. Remember, wares or services that have been used should be listed separately from wares or services that are proposed to be used. There is a requirement in the *Trade-marks Act*, that the wares and/or services applied for be in specific ordinary commercial terms. In other words, your application should state common names for the wares and services in a complete and specific way as possible. To assist you in this, the *Wares and Services Manual* appears on CIPO's Web site and provides acceptable identifications of many wares and services pursuant to paragraph 30(a), and also provides guidelines by way of example for identifying those wares and services not listed.
- ✓ **Date of first use in Canada** — If you have used your trade-mark in Canada in association with wares and/or services, you must provide the Trade-marks Office with the date of first use. Make sure that the date of first use does not fall AFTER the filing date of your application, which is the date your application is received by the Trade-marks Office. If this is the case, you should probably file under proposed use.
- ✓ **Acceptable date of first use** — You may not be aware that when you do not provide the day and/or month of the date of first use, the Trade-marks Office will assume this means either the last day of the month (if you don't provide the day), or the last day of the year (if you haven't provided the month). This means, for example, that if you file your application in 2004, and then state that you have used your trade-mark in association with your wares and/or services "since 2004", the Trade-marks Office will assume this means the last day of 2004. This can render your date of first use unacceptable, since it could fall AFTER your filing date.
- ✓ **Is it a word or is it a design?** — You must be clear about what you want to register. Is it a word or words not depicted in a special form? If so, simply state "The trade-mark is," and set out the word or words in upper or lower case letters. If the trade-mark is a design, state "The trade-mark is shown in the accompanying drawing," and attach the drawing to the application in this space (i.e. with glue or staples). **Do not do both**, as this could cause confusion and result in your application being delayed. If you are having trouble deciding what you want to register, you can refer to the **Application** section of this guide, or call the Client Service Center (CSC) at (819) 997-1936 and an Information Officer will be happy to answer any questions you may have.

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- √ **One trade-mark per application**—Only one trade-mark can be applied for on each application. Trying to register more than one word mark or design on the same application will result in the application being delayed. Again, if you're not sure what you want to register, call the CSC at (819) 997-1936.

**Abandonment**

An application for trade-mark registration may be considered abandoned if the applicant does not take steps to complete the process.

**Advertisement**

Publication of a trade-mark application in the *Trade-marks Journal*. Details are published to allow opportunity for challenges to the application (opposition).

**Allowance**

Acknowledgement by the Trade-marks Office that an application is eligible for registration. The applicant receives a "Notice of Allowance" (not the same as "Certificate of Registration").

**Assignment**

Transfer of trade-mark rights from the owner to another party.

**Certification marks**

Marks identifying goods or services meeting a defined standard (e.g. the Woolmark design on clothing).

**Clearly descriptive**

A word that clearly describes a feature of a product or service and therefore is not registrable as a trade-mark.

**Copyright**

Provides protection for literary, artistic, dramatic or musical works (including computer programs), and three other subject-matter known as: performance, sound recording and communication signal.

**Deceptively misdescriptive**

A word that may not be

registered as a trade-mark or part of a trade-mark because it is misleading.

**Disclaimer**

A statement that a certain word or portion of a trade-mark is not protected.

**Distinguishing guise**

The shaping of wares or their containers, or a mode of wrapping or packaging wares.

**Examination**

The process through which the Trade-marks Office determines whether an application for trade-mark registration warrants granting registration.

**Fees**

Specific sums payable to the Trade-marks Office for various services.

**Filing date**

The date a completed application is officially received at the Trade-marks Office and filed (not to be confused with registration).

**Incorporation**

The act of establishing a corporation by filing the required documents.

**Industrial design**

The visual features of shape, configuration, pattern or ornament (or any combination of these features), applied to a finished article of manufacture.

**Infringement (of a trade-mark)**

Violation of trade-mark rights through unauthorized use of a trade-mark.

**Integrated circuit topographies**

The three-dimensional configuration of the electronic circuits embodied in integrated circuit products or layout designs.

**Intellectual property**

A form of creative endeavour that can be protected through a trade-mark, patent, copyright, industrial design or integrated circuit topography.

**Licensee**

If an entity is licensed by or with the authority of the owner to use the mark, and the owner has direct or indirect control over the character or quality of the wares or services with which the mark is used, then the licensee's use of the mark or a trade-name including the mark is deemed to have, and to always have had, the same effect as use by the owner.

**Opposition**

The process whereby members of the public may object to the granting of a trade-mark registration if they have valid grounds for doing so.

**Patent**

Covers new inventions (process, machine, manufacture, composition of matter), or any new and useful improvement of an existing invention.

**Plant breeders' denomination**

A plant variety denomination is a right which is granted to the owner for the control over the multiplication and sale of reproductive material for a particular plant variety.

**Place of origin**

A word or depiction that designates the origin of a product or service and therefore may not be registered as a trade-mark.

**Preliminary search**

The search of Trade-marks Office records one should undertake before submitting an application for trade-mark registration. The search may turn up conflicting trade-marks and show that the application process would be in vain.

**Pre-publication verification**

A second search of Trade-marks Office records to ensure no confusing trade-marks exist before a given application is published in the *Trade-marks Journal*.

**Prima facie**

Sufficient to establish a fact or to raise a presumption of fact unless rebutted: *prima facie* evidence.

**Prohibited marks**

Marks which are specifically prohibited from use through subsection 9(1) of the *Trade-marks Act*.

**Proposed use**

A statement indicating intention to use a certain trade-mark and how that use will occur.

**Protected geographical indication**

A geographical indication is an indication which identifies that a wine or spirit originates from a territory where a quality, reputation or other characteristics of the wine or spirit is essentially attributable to its geographical origin and which is listed on the *List of Geographical Indications* kept by the Registrar.

**Registration**

The granting of formal recognition of a trade-mark by the Trade-marks Office.

**Registered trade-mark**

A trade-mark entered on the federal government's Trade-marks Register, which formally recognizes the owner's rights to the mark.

**Registrar of Trade-marks**

The official responsible for the Trade-marks Office.

**Trade-mark**

A word, symbol or design (or combination of these) used to distinguish the wares or services of one person or organization from those of others in the marketplace.

**Trade-mark agent**

A trade-mark agent is a person whose name is entered on the list of trade-mark agents and who is therefore entitled to practice before the Trade-marks Office.

**Trade-marks Act**

Federal legislation governing trade-mark registration in Canada.

**Trade-marks Journal**

A publication of the Trade-marks Office issued weekly and containing all approved applications and Office rulings.

**Trade-marks Office**

The federal government agency responsible for registering trade-marks in Canada.

**Trade-marks records**

The inventory of registered trade-marks and pending applications maintained electronically by the Trade-marks Office in Gatineau, Quebec.

**Trade-marks Register**

The official listing of registered trade-marks.

**Trade name**

The name under which a company chooses to operate. Trade names may or may not also be considered trade-marks, depending on the circumstances.